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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,238	02/26/2004	Phillip L. Lam	PERFECT-1/CIP-2	7970
1054 7590 12/17/2007 LEONARD TACHNER, A PROFESSIONAL LAW CORPORATION 17961 SKY PARK CIRCLE, SUITE 38-E IRVINE, CA 92614			EXAMINER MICHALSKI, SEAN M	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 12/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/789,238

Applicant(s)

LAM, PHILLIP L.

Examiner

Sean M. Michalski

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-5 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/25/2007 has been entered.

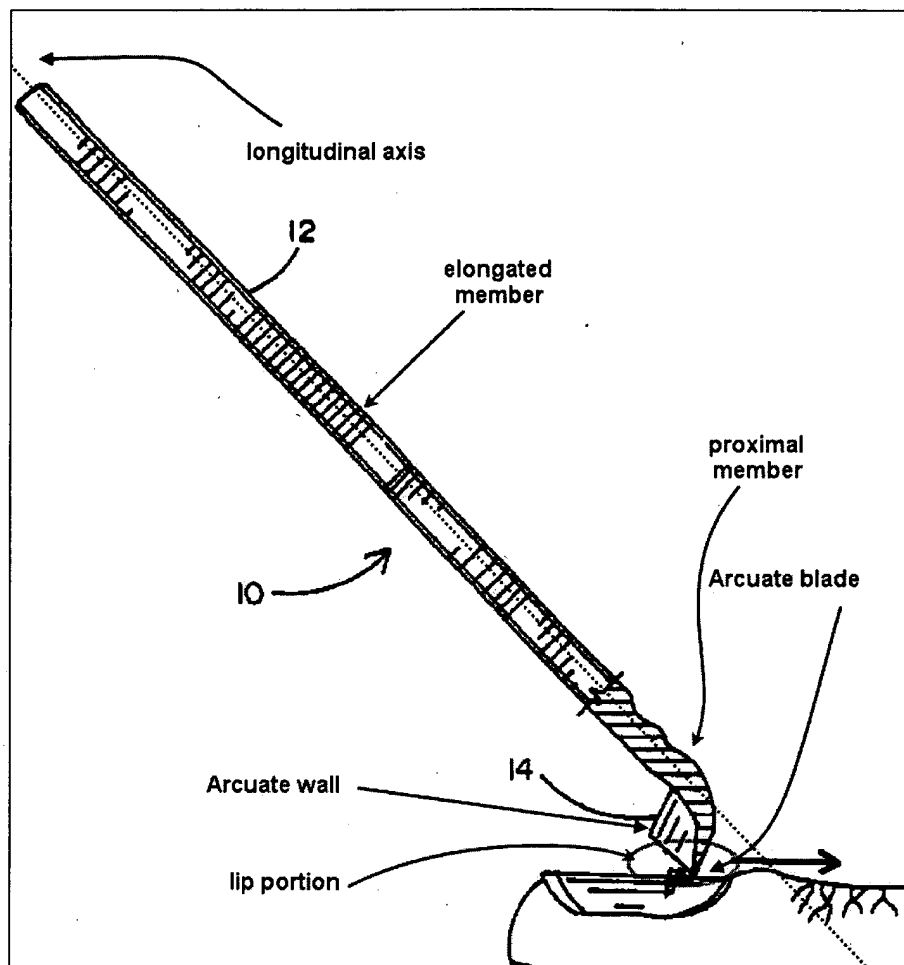
Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2,3, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baltierra (US 5,755,239) in view of Singer (US 6,289,901 B1), Hart and Henkel.

Baltierra teaches a manicuring tool with a proximal member and a longitudinally extending elongated member (seen below), the proximal member having an arcuate wall and an arcuate blade, both extending transverse (across) to the longitudinal direction of the longitudinally extending elongated member axis (the axis of the entire tool, and of the proximal member is a horizontal member) of the proximal member. Also see the figure below:



Although the claim limitation “releasably coupled” does not preclude Baltierra (since the proximal and distal members thereof could be sawed off- thus they are releasably coupled), in order to advance prosecution, this interpretation will not be relied on.

The term “lip portion” is met by Baltierra as seen above, since Tthe standard of claim interpretation during prosecution is as follows: “claims in a pending application should be given their broadest reasonable interpretation” consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). See additionally MPEP 904.01, and also In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during

examination, where applicant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the specification*, which would then control.

Baltierra does not teach a distal tool at a second end of the elongated member (handle).

It is common in the manicuring arts to provide tools at both ends, commonly some pairing from among, pushers, cutting tools, emory boards or cones, or other tools. (see Singer, Hart, and Henkel; among others)

It would have been obvious to include a distal member that was any one of a pusher, cutting tool, emory board or cone, since providing a second tool on the same handle is more cost effective and convenient than providing each tool with a separate handle.

It is also common in the manicuring arts to provide for the removal of proximal and distal members. See Singer et al. which teaches a proximal member (26) that is screwed onto(figure 6) or into (figure 2; figure 3) a handle (elongated member) with a tool (28) affixed on the proximal member. Singer also teaches a distal member (36 figure 1) that is releasably coupled by screw threads (figure 2; figure 4) to the same elongated member as the proximal member. It is clear from Singer that the working tool is removed from the proximal member which may be viewed as an adaptor. That is the provision of the implement is for “an implement having a connecting portion and a working portion” column 2 lines 4-5. See also column 23 and 24 which state that “other implements may also be employed with the elongated handle” meaning implements other than emery cones and/or nail scrapers.

It would have been obvious to one having ordinary skill in the art to provide both the proximal and distal members of Baltierra in view of Hart, Henkel or Singer with the provision

of releasable coupling of a connecting portion (proximal member) and a working portion (blade), so as to ensure that multiple sizes or shapes or styles of manicuring implements may be affixed to a common handle, since this represents a cost savings over the provision of a number of different tools with integral handles.

Regarding claim 3, Singer shows that there is a removable “an implement having a connecting portion and a working portion” being removable from an elongated member (column 2 lines 4-5). The working portion is also removable from the connecting portion (see figure 3).

It would have been obvious to one of ordinary skill in the art to make the blade of Balthierra in view of Hart, Henkel and Singer be removable from the proximal member (analogous to the working portion of singer being removable from the connecting portion) since as a working portion is used it becomes worn down, and replacing only the working portion of a proximal member saves material which in turn lowers the long term cost of using the tool.

Regarding claim 5, See specifically Hart, ‘1’ which is a pusher—see column 1 line 51-54 and column 2 lines 91-93.

Also see Henkel element 12, which is clearly a pusher. Other references showing pushers as common tools in the art are readily available.

It would have been obvious to one of ordinary skill in the art to have the distal member of Balthierra be a pusher member since a pusher member is a commonly desired manicuring tool, and having the distal member be a pusher will save time during a manicuring process since it eliminate the need to pick up a second tool- only rotate the tool already in a manicurists hand; and cost, since no second handle will need to be provided to utilize a pusher.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baltierra (US 5,755,239) in view of Singer (US 6,289,901 B1), Hart and Henkel, as applied to claims 2,3,5 and 13-16 above, and further in view of Grigoletto (US 5,620,455).

Regarding claim 4, Singer discloses that the working portion is “removably mounted on the connecting portion...in any suitable manner...” (column 4 lines 47-48).

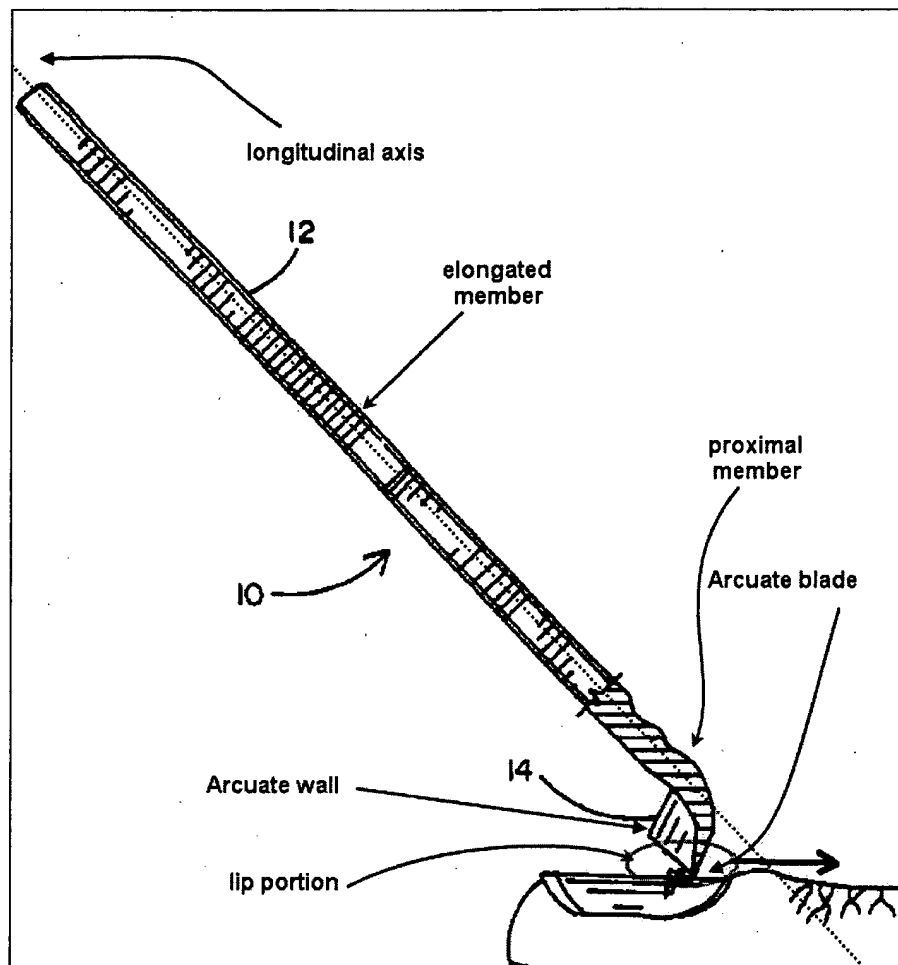
Art recognized equivalent ways of attaching include screws, friction fit, snap fit tabs or “retention caps”. Examiner takes official notice that one of ordinary skill in the art would have been capable of effecting any one of these connections for the connection of a blade to a connecting member, or a connecting member to a handle.

Grigoletto teaches the use of a retention cap (18 figures 2 and 4) for retaining a blade on another component of a manicure tool (specifically a multifunctional manicure tool).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a slide on blade with retention cap mechanism for attachment of the blade as taught by Grigoletto, instead of the screw in attachment method of attaching a blade as in the combination of Baltierra (US 5,755,239) in view of Singer (US 6,289,901 B1), Hart and Henkel; since manipulating a blade to screw it into a screw-hole (rotating an exposed blade surface) is more dangerous than using a retention cap mechanism which requires no turning over of the exposed blade in order to effect the connection. Additionally and alternatively, retention cap connections are art recognized equivalents with screw connections of blades.

Claims 2-5 and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baltierra in view of Singer (US 6,289,901 B1) in view of either one of Hart (1,476,508) and Henkel (1,113,168) further in view of Volinsky (US 5,342,379) and Parmley ("Plastic Snap Fit..." pp. 20-28 and 20-29).

Baltierra teaches a manicuring tool with a proximal member and a longitudinally extending elongated member (seen below), the proximal member having an arcuate wall and an arcuate blade, both extending transverse (across) to the longitudinal direction of the longitudinally extending elongated member axis (the axis of the entire tool, and of the proximal member is a horizontal member) of the proximal member. Also see the figure below:



Although the claim limitation “releasably coupled” does not preclude Baltierra (since the proximal and distal members thereof could be sawed off- thus they are releasably coupled), in order to advance prosecution, this interpretation will not be relied on.

The term “lip portion” is met by Baltierra as seen above, since Tthe standard of claim interpretation during prosecution is as follows: “claims in a pending application should be given their broadest reasonable interpretation” consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). See additionally MPEP 904.01, and also In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during

examination, where applicant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the specification*, which would then control.

Baltierra does not teach a distal tool at a second end of the elongated member (handle).

It is common in the manicuring arts to provide tools at both ends, commonly some pairing from among, pushers, cutting tools, emory boards or cones, or other tools. (see Singer, Hart, and Henkel; among others)

It would have been obvious to include a distal member that was any one of a pusher, cutting tool, emory board or cone, since providing a second tool on the same handle is more cost effective and convenient than providing each tool with a separate handle.

It is also common in the manicuring arts to provide for the removal of proximal and distal members. See Singer et al. which teaches a proximal member (26) that is screwed onto (figure 6) or into (figure 2; figure 3) a handle (elongated member) with a tool (28) affixed on the proximal member. Singer also teaches a distal member (36 figure 1) that is releasably coupled by screw threads (figure 2; figure 4) to the same elongated member as the proximal member. It is clear from Singer that the working tool is removed from the proximal member which may be viewed as an adaptor. That is the provision of the implement is for "an implement having a connecting portion and a working portion" column 2 lines 4-5. See also column 23 and 24 which state that "other implements may also be employed with the elongated handle" meaning implements other than emery cones and/or nail scrapers.

It would have been obvious to one having ordinary skill in the art to provide both the proximal and distal members of Baltierra in view of Hart, Henkel or Singer with the provision

of releasable coupling of a connecting portion (proximal member) and a working portion (blade), so as to ensure that multiple sizes or shapes or styles of manicuring implements may be affixed to a common handle, since this represents a cost savings over the provision of a number of different tools with integral handles.

Baltierra in view of Singer in view of Hart and Henkel does not teach specifically, that the removable portions (**proximal and distal**) be separable by a pair of apertures at each disconnection point, or that there are a pair of probes protruding from the second end of the proximal member (the member having the blade) and distal member (the member having the pusher), each probe having a securing tab projecting therefrom, wherein the pair of probes is received in said hollow cavity and each tab is received in respective apertures when the proximal or distal member is coupled to the elongated member (respectively).

Volinsky discloses a releasable proximal portion (20 figure 1) which carries a blade at the first end (seen clearly in figure 1) and has two probes (66 figure 1) with two respective tabs (68 figure 1) which may be inserted into respective hollow cavities (16 figure 1) with respective apertures (18 figure 1). The tabs may also be called retention caps.

Parmley teaches that snap-fit connections are applicable to a wide variety of mechanical connections and there are generic formulas that are useable by one of ordinary skill in the art. Parmley is a generic reference showing the level of sophistication that would be held by one of ordinary skill in the art in the selection and application of snap-fit connections. Parmley also indicated some extremely persuasive reasons to select a snap-fit *above* other connectors, such as press fit (as seen in Hunter et al. above) screw fit (also shown in Hunter et al.) and a sonic weld

(another known connection). See lines 12-15 of the first column on pp. 20-28. Parmley also shows a common snap-fit connection between two components in the figure on pp 20-28, where the land angle is 30 degrees and the return angle is 90 degrees, and the part with the two “probes” is inserted into a single cavity, that has two apertures for each of the tabs respectively at the end of each probe (to use applicants terminology). Clearly the use of dual probe, with dual tab, connections is known *generally* (Parmley) in addition to within the art (Volinsky).

In the same field of invention it would have been obvious to one skilled in the art at the time of the invention to modify Baltierra in view of Singer in further view of either Hart or Henkel by providing for removability of both the proximal member (connecting portion from Singer) and distal member (pusher) as taught by Volinsky. The motivation to combine is that in blood borne pathogen environments (such as surgery or manicure) disposal of the portions of equipment which come into contact with blood or other human fluids is desirable, and in some locations legally mandatory. By using a cartridge and permanent handle, waste is minimized, since the permanent handle may be reused, while the cartridge may be disposed of. This configuration “reduce[s] cost and decrease[s] medical waste” (column 1 lines 52-54). Additionally, separability by tab/probe configuration is desirable above screw on (which can loosen through vibration) and press fit (since that depends on friction and strain to maintain hold), whereas a snap fit can be designed to have “a pull-out force...hundreds of times larger than the push-in force.” (Parmley column 1 lines 17-19), which is desirable since it prevents unwanted disconnections.

Response to Arguments

5. The only changes to the application are in claim 2, which newly recites

- a. "arcuate lip portion"; the Balthierra lip portion is clearly arcuate. This recitation does not affect the previous rejection.
- b. "for rocking engagement of a surface therealong"; the lip portion of Balthierra as seen previously is inherently capable of rocking engagement with a surface. This is a statement of intended use which does not distinguish over the structure of Balthierra as previously applied.
- c. The blade member of Balthierra is clearly "disposed adjacent said lip portion"
- d. The blade member is clearly "supported against" the wall member, as previously recited.
- e. There is inherently "an arcuate cutting path defined" by rocking engagement of a surface by the lip portion of the proximal member of Balthierra as previously cited. If you rock something in concert with a blade against a surface, the blade being arcuate, the rocking is inherently capable of providing an arcuate cutting path generated by the blade.

These limitations, as addressed above were clearly present in the cited art/ rejections as presented in the previous action. A text reproduction copy of the previous action is presented for convenience above (Times New Roman font).

- 6. Applicant's arguments filed 10/24/2007 have been fully considered but they are not persuasive.

- a. Applicant relies too much on intended use statements in an attempt to distinguish over the prior art. The fact that Balthierra is disclosed as doing something different has no bearing on its *capability to so perform*. This claim interpretation is mandated in MPEP 2106 II C which states "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use."
- b. Regarding applicants allegation that "the dome portion...and blade edge..." "perform two distinct, yet related functions" renders the device ineffective as prior art is not persuasive. The standard of claim interpretation during prosecution is as follows: "claims in a pending application should be given their broadest reasonable interpretation" consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). See additionally MPEP 904.01, and also In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during examination, where applicant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the specification*, which would then control. The unreasonably broad recitations "wall" "lip portion" and "blade" are clearly, unquestionably met by

Balthierra, and the fact that Balthierra uses them to different ends has no bearing on their ability to be called, "arcuate lip portions" "blades" or "walls", since their structure is such that they fall within the bounds of the *broadest reasonable definition* of those terms.

c. Regarding applicants allegation that Balthierra is "specifically prescribed to then be pulled..." this does not matter. It is inherently capable of rocking; which is a statement of intended use. When rocked Balthierra inherently provides an arcuate cutting path, due to the fact that Balthierra's blade is arcuate itself. This claim interpretation is mandated in MPEP 2106 II C which states "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use."

d. Regarding applicants allegation that claim 2 "now more clearly recites..." (page 6 of 9, second paragraph) some combination of elements. This amounts to a general allegation of patentability and is ineffective in view of the comments above regarding the presence in Balthierra of each of the additionally claimed elements.

e. Applicant seems to believe that the statements of intended use are what sets the application apart, stating at pp 8 in the remarks section "even when considered together, fail to disclose the unique combination of elements now

more clearly recited ... *for the purposes and objectives disclosed in the subject ...application.*" Statements of intended use, purposes and objectives are not what defines an apparatus over the prior art, unless the prior art is *incapable of so performing*. This claim interpretation is mandated in MPEP 2106 II C which states "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use."

f. The allegation that the secondary references fail to cure the deficiencies of the Balthierra reference is moot, since the Balthierra reference has no such alleged deficiencies (pp8 of remarks).

Conclusion

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the previous Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Application/Control Number:
10/789,238
Art Unit: 3724

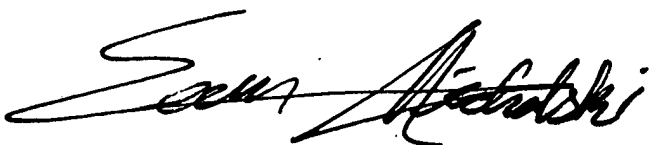
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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean M. Michalski whose telephone number is 571-272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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